

Serial No. 10/763,686  
Response dated September 15, 2004  
Reply to Office Action of June 17, 2004

Docket No. 5000-5141

### **REMARKS**

Claims 1-9 were previously pending in this application, with claim 1 in independent form. Claims 2 and 5 have been canceled without prejudice or disclaimer. New claims 10-17 have been added. Support for the new claims may be found throughout the specification, for example at paragraph 0019 on pages 8-9. Claims 1 and 3 have been amended, herein. Applicants submit that no new matter has been entered by way of this amendment. Applicants respectfully request reconsideration of the above-identified application, in view of the above amendment and following remarks.

### **Double Patenting**

The Examiner has provisionally rejected Claims 1-9 over co-pending Application No. 10/702,567. A terminal disclaimer overcoming this rejection is being submitted herewith.

### **Claim Rejection under 35 U.S.C. § 102**

Claims 1-2, 4-5 and 7-8 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Faure, et al. US Patent No. 5,073,207. Claims 1-2 and 4-9 have been rejected under 35 U.S.C. 102(b), as allegedly being anticipated by Regazzoni, et al. US Patent No. 4,997,622. Applicants respectfully submit that amended independent claim 1 and the claims directly or indirectly dependent therefrom, are patentably distinct from the cited references.

Amended independent claim 1 recites, *inter alia*:

A heat-resistant magnesium alloy...consisting essentially of...calcium...aluminum...[and] manganese and [having] a mass ratio of the Ca amount with respect to the Al amount, Ca/Al by mass, being 1 or more.

Applicants respectfully submit that the cited references do not teach or suggest a magnesium alloy consisting of calcium, aluminum and manganese having a calcium/aluminum (Ca/Al) mass ratio greater than or equal to 1, as recited in amended independent claim 1.

In Col. 4, Table 1, Faure, et al. disclose a listing of the various compositions tested during development of Faure, et al.'s invention. None of Faure, et al.'s tests 1-5, disclose, teach or suggest an alloy consisting of Ca, Al, and Mn, with a Ca/Al mass ratio greater than or equal to 1. Instead, Faure, et al. disclose the following Ca/Al mass ratios: Test 1: 2.5/5 (mass ratio = .5); Test 2: 2.5/9 (mass ratio = .278); Test 3: 2/8.5 (mass ratio = .235); Test 4: 4.5/7 (mass ratio = .643); and Test 5: 4.5/ 7 (mass ratio = .643) (See, Faure, et al. Table 1, Col. 4). Accordingly, Applicants submit that the claimed mass ratio recited in amended claim 1, greater than or equal to one, is not anticipated by the mass ratios disclosed in Faure, et al., all of which are less than one.

Similarly, Applicants submit that the trials disclosed in Regazzoni, et al. do not teach the claimed composition. Specifically, in Regazzoni, et al.'s compositions disclosing the elements Ca, Al and Mn, the Ca/Al ratio is 3.5/5 (Test No. 10) and 3.5/5 (Test No. 11) respectively, which are both less than 1 (See, Regazzoni, et al., Col. 6, Table I) . Accordingly,

for at least this reason, Applicants submit that Regazzoni, et al. do not anticipate amended independent claim 1.

Therefore, Applicants respectfully submit that the recited alloy consisting of Ca, Al, and Mn with a mass ratio of Ca/Al greater than or equal to 1, as in amended independent claim 1, is patentably distinct from the various alloys disclosed in the Faure, et al. and Regazzoni, et al, respectively. Further, Applicants respectfully submit that for at least a similar reason claims 2-9, which are directly or indirectly dependent on independent claim 1, as well as, new claims 10-17, are also patentably distinct from the cited references. Therefore, Applicants respectfully request withdrawal of these grounds of rejections.

**Claim Rejection under 35 U.S.C. § 103**

Claim 3 has been rejected under 35 U.S.C. § 103(a), as being unpatentable over Regazzoni, et al. Also, claims 3, 6 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Faure, et al. Applicants submit that claims 3, 6 and 9 are patentably distinct from the cited references. More specifically, claims 3, 6 and 9 are directly or indirectly dependent on independent claim 1. Accordingly, for at least the reason discussed above, with regard to amended independent claim 1 and the deficiencies identified in Faure, et al. and Regazzoni, et al., Applicants submit that claims 3, 6 and 9 are also patentably distinct from the cited references. Therefore, Applicants request withdrawal of these grounds of rejections.

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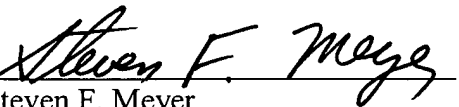
**CONCLUSION**

It is now believed that all pending claims are in condition for allowance. In view of these remarks, an early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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Dated: September 15, 2004

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